

## **REMARKS/ARGUMENTS**

Amendments to the title were made in the specification and abstract. No new matter has been added by any of the amendments to the specification and abstract.

Claims 1-24 are pending in the present application. Claims 3-5, 11-13 and 17-19 have been amended, and claims 22-24 have been added herewith. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 102, Anticipation**

Claims 1, 2, 5-10, 13-16 and 19-21 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Goldstein et al. (U.S. Publication No. 2003/0221167), hereinafter “Goldstein”. This rejection is respectfully traversed.

To anticipate, the prior art must teach all the claim elements and the claimed arrangement. Section 102 embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is “anticipated” by the prior invention. . . . Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” Focusing for a moment on *arrangement* – to anticipate, the reference must teach “all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIn v. Verisign* (Fed. Cir. 2008).

During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). This means that the words of the claim must be given their **plain meaning** unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are **construed to mean exactly what they say**. Thus, "heating the resulting

batter-coated dough to a temperature in the range of about 400°F to 850°F" required heating the dough, rather than the air inside an oven, to the specified temperature.) MPEP 2111.01(I) (emphasis added by Appellants). The Examiner is not interpreting the claim terms in accordance with their normal, plain meaning, as will now be shown.

With respect to claim 1, such claim recites “A method in a data processing system for managing display of a new document, the method comprising data processing system implemented steps of: displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of currently active browser windows including an indication of a presently displayed document in each respective browser window in the list of currently active browser windows; and replacing, in response to a user selection of a browser window from the list of currently active browser windows, **a document displayed in the browser window with the new document**”. As can be seen, in response to a user selection of a browser window from the list of currently active browser windows, a document that is displayed in the browser window *is replaced with the new document*.

In rejecting the claimed ‘replacing’ step, the Examiner alleges that Goldstein teaches such replacing in paragraph 0097, in that this cited passage is alleged to teach “Upon the selection of an open Custom Selection Window as the target, the software displays the selected Custom Selection Window 34”. Applicant urges that ‘displays’ a window, as allegedly taught by Goldstein, is not equivalent to ‘replacing’ a document that is *displayed* in a browser window with a new document when such terms are interpreted in accordance with their normal, plain meaning – since ‘replace’ means ‘to take the place of’ or ‘to provide a substitute for’.<sup>1</sup>

---

<sup>1</sup> **Replace**

**tr.v. replaced, replacing, replaces**

1. to put back into a former position or place.
2. To take or fill the place of.
3. To be or provide a substitute for.

Source: <http://www.thefreedictionary.com/replace>

**Replace**

-verb (used with object), -placed, -placing.

This distinction can clearly be seen by Goldstein's description in paragraph 0095 and Figures 6 and 7. For example, Goldstein states in paragraph 0095:

[0095] Referring to FIGS. 6 & 7, the software also allows the User to **add additional content items to an existing Custom Selection Window 34**. To do this, the User preferably **first divides a Frame 37 of an existing content item 18 in the Custom Selection Window 34 to add a new frame to the window**. The Frame Toolbar 38, which appears over the content item 18 in the Custom Selection Window 34, includes New Frame Bottom, New Frame Top, New Frame Right, and New Frame Left icons 40, 42, 44, 46 (or menu items) that add a new frame below, above, to the left or to the right, respectively, of the existing content item 18. The software preferably divides the frame 36 of the selected content item 18 into two, equal, sub-frames 48, 50, **with one of the frames 48 occupied by the existing content item 18 and the other frame 50 blank**. Then, the User selects an additional content item in the manner described above.

As can be seen, and with reference to Goldstein's Figure 6, the additional content item that is selected from a list as per Goldstein paragraph 0096 (which is cited by the Examiner as teaching the claimed 'displaying' step) is *added to a newly created frame* (element 50) that is positioned *adjacent to the existing content item* (element 48). Importantly, the existing content item 18 continues to be displayed. Therefore, this display of an additional, newly added content item does not replace a document displayed in the browser window with the new document, as per the features of claim 1, but instead concurrently displays both the existing displayed content item and the new content item.

By analogy, when someone replaces a tire on their car, they do not mount the tire adjacent to an existing tire, but instead the existing tire is removed and the new tire is installed in its place – thereby *replacing* the tire on the car. Similarly, Goldstein's display of a new content adjacent to existing content is not a replacement of the existing content with new content, and therefore Goldstein does not teach the claimed step of “*replacing*, in response to a user selection of a browser window from the list of currently active browser windows, *a document displayed in the browser window with the new*

---

1. to assume the former role, position, or function of; substitute for (a person or thing):  
*Electricity has replaced gas in lighting.*
2. to provide a substitute or equivalent in the place of: *to replace a broken dish.*

Source: <http://dictionary.reference.com/browse/replace>

*document*”. This can also be seen by Goldstein’s statement at paragraph 0098, where he states:

[0098] Referring to FIG. 9, the software then displays the modified Custom Selection Window 34, which now contains *both* the first content item 18 (e.g., in the top frame 48) and the additional content item 58 (in the bottom frame 50). (emphasis added by Applicant)

This description of displaying an additional, newly added content item – in which *both* the original content item *and* the new content item are displayed in the Custom Selection Window 34 - does not teach *replacing* a document displayed in a browser window *with* the new document, as per the features of claim 1, but instead describes concurrently displaying *both* the pre-existing displayed content item *and* the new content item. Therefore, as the cited reference does not teach all of the limitations arranged or combined in the same way as recited in the claim, it is urged that claim 1 has been erroneously rejected under 35 U.S.C. § 102.

Applicant initially traverses the rejection of claims 2 and 5-8 for reasons given above with respect to claim 1 (of which Claims 2 and 5-8 depend upon).

Further with respect to claim 2, such claim recites “promoting the browser window to a top of a window hierarchy”. As can be seen, per claim 2 the browser window is promoted to a top of a window hierarchy.

In rejecting claim 2, the Examiner cites Goldstein’s description at paragraph 0139 as teaching such window promotion, as there it describes that a window “will retain the Custom Selection Window 34 as the top window”. Applicant urges that ‘retain’, as alleged to be taught by Goldstein, is not equivalent to ‘promote’, as claimed.<sup>2</sup> By analogy, a person who *retains* their current job position/title is not *promoted*. A person

---

<sup>2</sup> **promote**

—verb (used with object), -moted, -moting.

to advance in rank, dignity, position, etc. (opposed to DEMOTE ).

Source: <http://dictionary.reference.com/browse/promote>

who gets a *promotion* with respect to their current job position does not *retain* their current job position. In similar fashion, a statement that a window is ‘retained’ does not describe a window being ‘promoted’. Thus, it is further urged that claim 2 has been erroneously rejected as the cited reference does not teach all of the limitations arranged or combined in the same way as recited in the claim.

Further with respect to claim 5, Applicant has amended such claim to further emphasize the browser windows aspect of the claims. In contrast, the cited Goldstein reference does not describe a list of browser windows that are open, but instead describes a list of “Custom Selection Windows”. This Custom Selection Windows list is a list of windows that a user has placed specialized content into, such as a particular picture (Goldstein paragraph 0089). It is not a list of all currently open browser windows, as is provided by the features of amended claim 5. Thus, it is further urged that amended claim 5 is not anticipated by the cited reference.

Applicant traverses the rejection of claims 9, 10, 13-16 and 19-21 for similar reasons to those given above with respect to claim 1.

Applicant further traverses the rejection of claims 10 and 16 for similar reasons to the further reasons given above with respect to claim 2.

Applicant further traverses the rejection of claims 13 and 19 for similar reasons to the further reasons given above with respect to claim 5.

Therefore, the rejection of claims 1, 2, 5-10, 13-16 and 19-21 under 35 U.S.C. § 102 has been overcome.

## **II. 35 U.S.C. § 103, Obviousness**

Claims 3, 4, 11, 12, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goldstein and Weiss et al. (U.S. Publication No. 2003/0014415), hereinafter “Weiss”. This rejection is respectfully traversed.

Applicant initially urges error in the rejection of claims 3, 4, 11, 12, 17 and 18 for similar reasons to those given above with respect to claim 1.

During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). This means that the words of the claim must be

given their **plain meaning** unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are **construed to mean exactly what they say**. MPEP 2111.01(I) (emphasis added by Appellants). The Examiner is not interpreting the claim terms in accordance with their normal, plain meaning, as will now be shown.

For example, and with respect to claim 3 (and similarly for claims 11 and 17), such claim recites “wherein the indication is a document name from a title bar”. As can be seen, the features of claim 3 are directed to the indication aspect of claim 1 (an indication of a *present displayed document* in each respective browser window), where such indication is a document name from a title bar.

In rejecting claim 3, the Examiner states that Weiss teaches:

“displaying a list of web page search results including the web page titles that would normally be displayed in the web browser title bar (see Weiss paragraph [0158])”.

The Examiner then states that it would have been obvious to one of ordinary skill in the art “to automatically *retrieve the indication information from the title bar of the document as taught by Weiss* in the invention of Goldstein in order to reduce the amount of data that the user is required to enter manually” (emphasis added by Applicant). Applicant will now show that (1) the Examiner has mischaracterized the teachings of Weiss, since Weiss does not teach any type document title bar retrieval, and (2) a person of ordinary skill in the art would not have been motivated to modify Goldstein as alleged by the Examiner.

Contrary to the Examiner’s assertion in rejecting claim 3, Weiss does not teach “automatically *retrieve the indication information from the title bar of the document*”, as alleged by the Examiner in rejecting claim 3 (see page 6, middle paragraph, of the present Office Action dated 4/6/2009). Instead, Weiss describes generating a search results preview page that is generated in response to a user entering a search query (Weiss

paragraph [0157])). The ‘previews’ that are presented to a user by Weiss are previews of Web page content (Weiss paragraph [0157], lines 3-4). There is no type of title bar as such web page content for which ‘previews’ are displayed is not described as being retrieved from any type of browser or window that might have such a title bar.<sup>3</sup> Because Weiss does not present previews of content displayed in one or more web browsers or windows, there is no title bar associated with the content that Weiss retrieves and presents in the special preview mode, and therefore Weiss does not teach “automatically retrieve the indication information from the title bar of the document”, as alleged by the Examiner in rejecting claim 3. Thus, claim 3 has been erroneously rejected due to this fundamental mischaracterization of the teachings of Weiss, and the resulting *prima facie* obviousness deficiency.<sup>4</sup>

As to the no motivation to modify issue with respect to claim 3 (and similarly for claims 11 and 17), the Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In determining obviousness, the scope and content of the prior art are... determined; differences between

---

<sup>3</sup> **Title bar**

From Wikipedia, the free encyclopedia

In computing, the **title bar** (or **titlebar**) consists of that part of a window where the title of the window appears. Most graphical operating systems and window managers position the title bar at the top of the application window as a horizontal bar.

Default title-bar text often incorporates the name of the application and/or of its manufacturer. The name of the host running the application also appears frequently.

<sup>4</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP 2143.03; *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).” Applicant urges that the Examiner has failed to meet their burden of proof in establishing some articulated reasoning with some rationale underpinning to support a legal conclusion of obviousness, as will now be shown.

As earlier alluded to, the Examiner states that it would have been obvious to one of ordinary skill in the art “to automatically *retrieve the indication information from the title bar of the document as taught by Weiss* in the invention of Goldstein in order to reduce the amount of data that the user is required to enter manually” (emphasis added by Applicant). Because Weiss does not teach what the Examiner alleges it teaches (as described hereinabove), and such mischaracterization is the specific rationale that the Examiner provides in their attempt to establish why a person of ordinary skill in the art would have been motivated to modify the teachings of Goldstein, the resulting obviousness conclusion is wrong because it is based on alleged facts that are not of record (Weiss does not teach retrieving information from a title bar, as alleged by the Examiner in their attempt to establish motivation for modifying Goldstein).

Further, Goldstein provides the ability for user-defined title bars because Goldstein’s system is directed to a user selecting sub-sets or sub-portions of a currently existing web page or document (Goldstein paragraphs [0022] and [0082]). For example, the user may select a text string that is currently displayed in a preexisting window (Goldstein paragraph [0084] and [0086]). Therefore, a person of ordinary skill in the art

would not have been motivated to modify the teachings as alleged by the Examiner in order to reduce the amount of time of data entry, as Goldstein requires such data entry in order to name or tag a subset of displayed content. In addition, such data entry is also usable to further enhance Goldstein by allowing this user input to perform searches for additional content (Goldstein paragraph [0087]). Thus, a person of ordinary skill in the art would not have been motivated to modify Goldstein to eliminate this user naming/tagging step.

Therefore, it is urged that claim 3 (and similarly for Claims 11 and 17) has been erroneously rejected, as (1) the Examiner has mischaracterized the teachings of Weiss, since Weiss does not teach any type document title bar retrieval, and (2) a person of ordinary skill in the art would not have been motivated to modify Goldstein as alleged by the Examiner.

Further with respect to claim 4 (and similarly for claims 12 and 18), such claim recites “wherein the indication is a thumbnail of the document”. As can be seen, the features of claim 4 are directed to the indication aspect of claim 1 (an indication of a *present displayed document* in each respective browser window), where such indication is a thumbnail of the document displayed in each respective browser window. For similar reasons to those given above with respect to claim 3, the Weiss thumbnails that the Examiner alleges as being equivalent to the claimed thumbnails to not provide any type of indication of a present displayed document in each respective browser window, as claimed by claim 4 in combination with claim 1. Instead, the Weiss thumbnails indicate the results of a search inquiry, and these results are not results of anything displayed in browser windows, as claimed by claim 4 in combination with claim 1. Thus, it is further urged that claim 4 (and similarly for claims 12 and 18) has been erroneously rejected due to this additional *prima facie* obviousness deficiency.

Therefore, the rejection of Claims 3, 4, 11, 12, 17 and 18 under 35 U.S.C. § 103 has been overcome.

### **III. Newly Added Claims**

Claims 22-24 have been added herewith. Examination of such claims is respectfully requested.

### **IV. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 24, 2009

Respectfully submitted,

/Wayne P. Bailey/

Wayne P. Bailey  
Reg. No. 34,289  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Attorney for Applicant